

12884  
No. 12,892

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

---

SIGNAL MANUFACTURING COMPANY, a corporation and  
CHARLES SCHNEIDER, d. b. a. SIGNAL MANUFACTURING  
COMPANY,

*Appellants,*

*vs.*

THE KILGORE MANUFACTURING COMPANY, a corporation,

*Appellee.*

---

## BRIEF FOR APPELLANTS.

---

C. A. MIKETTA,

W. W. GLENNY,

909 Van Nuys Building,  
Los Angeles 14, California,

*Attorneys for Defendants-Appellants.*



## TOPICAL INDEX

	PAGE
Introduction .....	1
Statement of jurisdiction.....	2
Brief statement of the case.....	3
Summary of defendant's argument.....	6
The patent in suit.....	7
No presumption of validity attaches to the patent in suit.....	11
The evidence in this case compels judgment of invalidity (Plate I) .....	12
Plaintiff's admissions compel holding claims 10 and 11 invalid (Plates II to IV).....	17
There is no invention in making a container or shell from one piece of metal.....	21
The prior patents conclusively show lack of invention (Plates VI to IX).....	32
Plaintiff cannot point to a new result. The old combination is invalid .....	34
Claims 10 and 11 are for an inoperative, incomplete aggregation of old elements.....	40
Claims 10 and 11 are invalid because they claim more than was invented .....	41
Defendant does not infringe.....	43
Obviously erroneous findings must be overruled.....	46
Defendant should be awarded costs and reasonable attorney's fees	48
Summary and conclusion.....	51

## TABLE OF AUTHORITIES CITED

CASES	PAGE
Bailey v. Sears & Roebuck, 115 F. 2d 904.....	28, 36
Bassick Co. v. Hollingshead Co., 298 U. S. 415.....	42
Bates v. Coe., 98 U. S. 31.....	43
Brinkerhoff v. Aloe, 146 U. S. 515, 36 L. Ed. 1068, 13 S. Ct. 221 .....	28
Brooks v. Fiske, 15 How. (56 U. S.) 212.....	43
Carbice Corp. v. American Patents Dev. Co., 283 U. S. 420.....	31
Cartridge Co. v. Cartridge Co., 112 U. S. 624.....	23, 37
Cleveland Punch & Shear Works Co. v. E. W. Bliss Co., 145 F. 2d 991.....	26
Concrete Appliances v. Gomery, 269 U. S. 177.....	31
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405 .....	34
Cuno Engineering Corp. v. The Automatic Devices Corp., 314 U. S. 84.....	31, 40
Dunbar v. Myers, 94 U. S. 187.....	45
Enterprise Railway Equipment Co. v. Pullman Standard Car Mfg. Co., 95 F. 2d 17.....	26
Evr-Kleen Seat Pad Co. v. Firestone Tire & Rubber Co., 118 F. 2d 600.....	28
General Bronze Corp. v. Cupples Products Corp. 89 P. Q. 355....	9
General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364 .....	34, 38, 39
General Electric Co. v. Yost Electric Mfg. Co., 139 Fed. 568.....	25
Goodman v. Paul E. Hawkinson, 120 F. 2d 167.....	36
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147.....	29, 35, 40, 47
Grinnell Washing Machine Co. v. Johnson Co., 247 U. S. 426, 62 L. Ed. 1196, 38 S. Ct. 547.....	27, 36
Guardian Trust Co. v. Kansas City Southern Ry. Co., 28 F. 2d 233 .....	51

	PAGE
Hailes v. Van Wormer, 20 Wall. 353.....	31
Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1.....	35
Heath v. Frankel, 153 F. 2d 369.....	28
Hill v. Federal Trade Commission, 124 F. 2d 104.....	17
Howard v. Detroit Stove Works, 150 U. S. 164.....	24
Hubbell v. United States, 179 U. S. 77.....	23, 37, 43
I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429.....	43
James Heddon's Sons v. American Fork & Hoe Co., 148 F. 2d 230 .....	26
Kalich v. Paterson Pacific Parchment, 137 F. 2d 649.....	28
Keszthelyi v. Doheny Stone Drill Co., 59 F. 2d 3.....	30
Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274.....	34, 45
King v. Gallun, et al., 109 U. S. 99, 27 L. Ed. 870.....	23
Kruger v. Whitehead, 153 F. 2d 238.....	39
Lane Wells Co. v. M. O. Johnston Oil Field Service, 181 F. 2d 707 .....	30, 47
Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545 .....	28, 40, 42
Magarian v. Detroit Products Co., 128 F. 2d 544.....	36
Market Soda Fountain Co. v. Sample, 130 Fed. 145.....	12
McClain v. Ortmayer, 141 U. S. 419.....	45
McClintock v. Gleason et al., 94 F. 2d 115.....	12
Merrill v. Yeomans, 94 U. S. 568.....	45
Mettler v. Peabody Engineering Corporation, et al., 77 F. 2d 56 .....	12, 36
National Battery Co. v. Western Molded Products Co., 39 Fed. Supp. 954; aff'd 132 F. 2d 510.....	26
Oscanyan v. Arms Co., 103 U. S. 261.....	17
Pickering v. McCullough, 14 Otto. 310.....	31
Pointer v. Six Wheel Corp., 177 F. 2d 153.....	48
Powers-Kennedy Contracting Corp. v. Concrete Mixing & Con- veying Co., 282 U. S. 175.....	31

	PAGE
Ray-O-Vac Co. v. Goodyear Tire & Rubber Co., 45 Fed. Supp. 927 .....	26
Reinharts, Inc. v. Caterpillar Tractor Co., 85 F. 2d 628.....	45
Richards v. Chase Elevator Co., 158 U. S. 299.....	27
Saranac Machinery Co. v. Wire Bounds Co., 282 U. S. 704.....	45
Schick Service, Inc., et al. v. Jones, etc., 173 F. 2d 969.....	21, 30
Schumacher v. Cornell, 96 U. S. 549.....	43
Standard Caster & Wheel Co. v. Caster Socket Co., 113 Fed. 162	25
Stoody Co. v. Mills Alloys, Inc., 67 F. 2d 807.....	12
Thatcher Heating Co. v. Burtis, 121 U. S. 286.....	31
The Kilgore Manufacturing Company, et al. v. Triumph Ex- plosives, Inc., et al., 37 Fed. Supp. 766.....	4, 11
Thompson v. Baisselier, 114 U. S. 1.....	45
Timken Detroit Axle Co. v. Cleveland Steel Products Co., 138 F. 2d 267; cert. den. 326 U. S. 725; rehear. den. 326 U. S. 808 .....	39
Toledo Pressed Steel v. Standard Parts, Inc., 307 U. S. 350....	30, 40
Triumph Explosives, Inc. v. Kilgore Mfg. Co., 128 F. 2d 444....	49
United Carbon Co. v. Binney & Smith Co., 317 U. S. 228.....	39
United States Appliance Corp. v. Beauty Shop Supply Co., Inc., 121 F. 2d 149.....	28
Vance v. Campbell, 66 U. S. 427.....	43
Wagner et al. v. Meccano Limited, 246 Fed. 603.....	25
Water Meter Co. v. Desper, 101 U. S. 332.....	34
Waterhammer Arrester Corp. v. Tower, 156 F. 2d 775.....	39

## STATUTES

Federal Rules of Civil Procedure, Rule 36.....	17
United States Code Annotated, Title 35, Sec. 70.....	50, 51

No. 12,892  
IN THE  
**United States Court of Appeals**  
FOR THE NINTH CIRCUIT

---

SIGNAL MANUFACTURING COMPANY, a corporation and  
CHARLES SCHNEIDER, d. b. a. SIGNAL MANUFACTURING  
COMPANY,

*Appellants,*

*vs.*

THE KILGORE MANUFACTURING COMPANY, a corporation,  
*Appellee.*

---

**BRIEF FOR APPELLANTS.**

---

**INTRODUCTION.**

This is an appeal by defendant-appellant (hereinafter referred to as defendant) Charles Schneider, doing business as Signal Manufacturing Company, and his predecessor corporation, from a final judgment entered by the District Court of the United States for the Southern District of California, Central Division, holding valid and infringed claims 10 and 11 of patent No. 1,947,834 to Driggs and

---

\*The parties shall be referred to as plaintiff and defendant. The references to the printed record, including Volume II of Exhibits, shall be by R. followed by page number. Emphasized matter in decisions is by defendant.



Faber. All other claims (claims 1-9 and 12-23) have been held invalid.

The Court found that defendant-appellant had not been guilty of acts of unfair competition and the second count of the complaint stands dismissed. The Court ordered an injunction and an accounting that plaintiff recover costs from the defendant and reserved decision on plaintiff's prayer for increased damages and attorneys' fees until after determination as to plaintiff's damages before a Special Master.

This appeal is taken because the evidence and the law do not support the findings. It is urged that claims 10 and 11 are invalid and not infringed and that the Court erred in failing to award attorneys' fees to defendant.

## STATEMENT OF JURISDICTION.

The Trial Court had jurisdiction of the original complaint and answer as well as the second amended answer and counterclaim and of the parties under the patent laws of the United States and diversity of citizenship, jurisdiction being admitted by defendant [paragraph III of answer to first complaint and paragraph III of second amended answer, R. 10 and 19]. Defendant, in its second answer, included a counterclaim for declaratory judgment as to invalidity of all claims not originally in issue [R. 27].

Defendant filed a timely notice of appeal [R. 77], a concise statement of points on appeal [R. 78] and adopted such statement of points [R. 190].



## BRIEF STATEMENT OF THE CASE.

The Kilgore Manufacturing Company is an Ohio corporation engaged in the manufacture of various types of smoke bombs, signal flares, etc. For many years it operated under a license granted it by the patentees of the patent in suit and since about July, 1947, has had title to the patent in suit. The patent relates to a signal shell, to be fired from a hand gun, the shell being shot into the air to there explode and discharge a parachute carrying a lighted signal flare.

Appellant (defendant below) was part owner of its predecessor corporation, Signal Manufacturing Company, a California corporation, and since about November, 1947, appellant Charles Schneider acquired the said corporation and has been doing business as Signal Manufacturing Company. Defendant's principal place of business is at Los Angeles, California; defendant manufactures parachute signal flares at a plant near Saugus, California.

Defendant was originally charged with infringement of all of the claims of the patent in suit and plaintiff's Exhibit 2, attached to the complaint, was an exemplar of defendant's signal flare which was charged to infringe. Plaintiff then limited the charge of infringement to the construction shown in claims 1-11 and 15 and 16; subsequently, in view of interrogatories filed by defendant, plaintiff withdrew claims 6, 15 and 16. Inasmuch as defendant had been caused to prepare on all of the claims (as originally charged), defendant filed a counterclaim for declaratory judgment, holding all of the claims invalid and not infringed.

Both of the inventors of the patent in suit No. 1,947,834 are dead, but the patent in suit was involved in litigation, together with other patents, in the case of *The Kilgore Manufacturing Company, et al. v. Triumph Explosives, Inc., et al.*, 37 Fed. Supp. 766. In that case the patent in suit was held not infringed and some doubt was expressed as to its validity, the Court stating:

“It is in no sense a pioneer patent, but if valid, is limited (in combination with other elements specified in the claims) to the particular form of construction described, that is, a one-piece aluminum cylinder of extruded metal with a relatively heavy base and thin side walls.”

In referring to the extruded metal construction, the Court, in the *Triumph* case, also stated:

“As appears from the file wrapper of the patent, there is nothing novel in this of itself.”

During pretrial, plaintiff admitted that if there was any invention in the patent in suit, it lay in making the bottom of the case or shell integral with the side wall, out of one piece of metal.

“I said the new element was a one-piece projectile shell including relatively thin side walls and a heavy base.” [R. 86.]

During trial, plaintiff’s counsel admitted that the combination of elements was not new:

“The Court: So everything that is described in the patent in suit in combination has been previously claimed in combination, has it not, by these same inventors—

Mr. Schmieding: Except the one-piece shell.

The Court: —in prior art, except that now they say we combine all these things with a one-piece shell?

Mr. Schmieding: That's right, your Honor.

\* \* \* \* \*

The Court: The combination has been the same, except that the shell has been in more than one piece?

Mr. Schmieding: That's right." [R. 145.]

The issue is very simple and can be stated in few words: **Is it invention to substitute a one-piece container for a two-piece container in an old combination?**

By dilatory tactics, by needless and baseless argument and by repudiation of its own admissions, plaintiff prolonged the trial unnecessarily and confused the Trial Court. Such a simple issue should not require a four-day trial and a rehearing and additional arguments.

The Trial Court in the instant case appeared to be confused at the conclusion of the case. The Court first held claims 1-5 invalid for lack of invention and claims 7-11 valid and infringed [R. 149]. Within a few minutes, the Court held claim 9 invalid [R. 151] and a few minutes later held claims 7 and 8 valid but not infringed [R. 153]. Plaintiff thought claims 7 and 8 should be held invalid and the Court then so held [R. 154]. A few minutes later plaintiff admitted that claims 6 and 12 were invalid and the Court so held [R. 154-155]. Plaintiff then admitted that claims 12-23 were invalid and the Court so held [R. 155].

It is evident that plaintiff's charge of infringement was not made in good faith because of the ready manner in which most of the claims were admitted invalid when the Trial Court was attempting to reach a decision. Actually, claims 10 and 11 are invalid and could not possibly be infringed because of limitations in such claims and upon plaintiff's own admissions.

## BRIEF SUMMARY OF DEFENDANT'S ARGUMENT.

The concise statement of defendant's points on appeal appears in the record, pages 78 and 79. The argument can be divided into three sections relating to the issues of invalidity, lack of infringement and on the issue of costs.

I. Defendant urges that the decision of the Trial Court must be reversed and claims 10 and 11 be held invalid because:

(a) Claims 10 and 11 are invalid because they do not define an invention. There is no invention in making an article such as a shell out of one piece of metal so that the walls and bottom are integral.

(b) Claims 10 and 11 are invalid because they are for an **aggregation of admittedly old elements**, which act in the **same way** and for the **same purpose** and are in the **same relationship** as that shown in prior expired patents.

(c) The Trial Court misapplied and made an error of law in holding claims 10 and 11 valid. Findings 9 and 13 [R. 67-68] are contrary to the record in this case.

II. Defendant does not and cannot infringe because:

(a) Claims 10 and 11 are specifically limited to a form of shell not used by defendant.

(b) Uncontradicted evidence showed that defendant never manufactured the article defined in claims 10 and 11.

(c) Not a shred of evidence exists in support of finding 15 [R. 68].

III. The judgment is in error in assessing costs against the defendant and actually costs and attorneys' fees should be assessed against the plaintiff because:

(a) The record is replete with evidence that plaintiff did not present the action in good faith.

(b) Plaintiff admitted that there was no invention involved two years before the trial, but persisted in repudiating its admissions and unnecessarily prolonging the trial in the hope of driving defendant to bankruptcy.

(c) Plaintiff has attempted to becloud the issue and has advanced baseless arguments.

(d) The Court erred in finding "conscious, deliberate and wilful infringement" since this finding has no basis in the evidence. Costs and expenses should be awarded to defendant and against the plaintiff.

Throughout this brief specific reference will be made to the record to clearly show the merit of defendant's contentions. It is expected that plaintiff will again attempt to becloud the issue by generalities having no basis in fact.

## **THE PATENT IN SUIT.**

Patent No. 1,947,834 in suit is entitled "Flare Signal" and was issued in February, 1934, to Driggs and Faber. This patent (expired February, 1951) is Exhibit 1 in Volume II of the record in this case. The file history of the patent is defendant's Exhibit A, a physical exhibit.

The device of the patent is simple, but no single drawing shows what defendant makes. Fig. 2 shows the general assembly with a base cartridge 27 (at right end) provided with a central percussion cap 36. Fitted into the cartridge is the cylindrical container 2 having a bottom 1



in which there is positioned a delay fuse in the form of an eyelet 4 with fuse composition 5. Black powder 35 is between the bottom of the container 2 and the cartridge.

When the flare is shot from a breech loading gun, the black powder shoots the container 2 into the air; a few seconds later the delay fuse ignites the ejection charge 6 and blows the contents out of the container.

The container carried a flare candle 10 which is connected to a parachute 20 by lines. In order to prevent the parachute from being wadded up during ejection, it is wrapped around a thrust stick 21.

The final combination is therefore the cartridge of Fig. 2 with the container of Fig. 1.

It is to be noted that the container need not be made of one piece of metal. Fig. 3 shows a container, with the same contents as Fig. 1, but with a separate, screwed-on bottom. Thus the patentees show that a two-piece container is just an alternative for a one-piece container.

The Trial Court held claims 1-9 and 12-23 invalid and actually plaintiff admitted that these claims were invalid.

It is to be noted that the cartridge of Fig. 2 is provided with an outwardly extending shoulder 27a at its base. This permits the shell to be used in breech-loading guns, as any shot gun shell. Fig. 4, however, shows a long cartridge with an annular groove near the bottom; this shell cannot be used in breech-loading guns.

“Q. And therefore, Figure 4 really relates to a muzzle loading shell which is of the type which you say was used from aircraft? A. Yes, sir, that’s definitely an aerial shell.” [R. 143.]

The Patent Office rejected many claims for lack of invention and some of these claims are reproduced on pages 178-180 of the record. Plaintiff admitted that the following claim was rejected for lack of invention and cancelled by plaintiff:

“38. In combination, a one-piece drawn shell case having an expelling charge and delay fuse in the base thereof, a gas-producing member attached to a parachute contained therein and ejectable therefrom by said expelling means, and a detachable cartridge case mounted on one end of the shell case having a propelling charge and primer therefor mounted therein.”  
[R. 180.]

Claims 10 and 11 cannot cover what is in this cancelled claim and must show invention elsewhere. This is particularly true since

“The Court: If there is any invention here at all, it seems to me, in view of the prior art, it has to be a very narrow combination, very narrow in scope.  
\* \* \*

Mr. Schmieding: It is in a crowded art.” [R. 146-147.]

“\* \* \* and it is well settled that in a crowded art and in a combination patent, the claims are to be limited to the specific language used in the claim. *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U. S. 42; *Shakespeare Co. v. Perrine Mfg. Co.*, *et al.*, 8 Cir. 91 F. (2d) 199.”

*General Bronze Corp. v. Cupples Products Corp.*  
(C. A. 8), ..... F. 2d ....., 89 P. Q. 355.



Claim 11, which is the most complete claim, reads as follows:

“11. In combination,  
a cartridge case having a base with an annular groove,  
a propelling charge chamber and a fuse mounted therein, said base carrying side walls,  
a telescopically-arranged shell mounted therein having a relatively heavy integral base and thin side walls,  
a fuse in the base of said shell communicating with the propelling charge of the cartridge case on one side and with an expelling charge in the shell on the other side,  
a flare and a parachute in said shell,  
and means to prevent the collapse of said parachute,  
and detachable closure means for said shell engaging said means for preventing the collapse of the parachute.”

Attention is called to the fact that the claim specifically requires a case **“having a base with an annular groove.”** Those words call for a device like Fig. 4, which is a muzzle loader, as admitted by plaintiff [R. 143]. **Defendant has never made a muzzle loading device; there is no infringement;** there is no foundation for the Trial Court’s gratuitous finding of “wilful” infringement [Finding 15, R. 68].

Lack of invention will become apparent in subsequent comparison of this claim with (1) plaintiff’s own admissions, and (2) the prior art which was not referred to by the Patent Office in allowing the claims.

## NO PRESUMPTION OF VALIDITY ATTACHES TO THE PATENT IN SUIT.

In prior litigation the District Court of Maryland stated, with respect to the Driggs and Faber patent in suit:

“It is in no sense a pioneer patent”

and the 4th Circuit stated:

“The validity of the patent is not free from doubt, but the question need not be decided here; \* \* \*”

*Kilgore Mfg. Co. v. Triumph Explosives, Inc.*, 128 F. 2d 444.

It is to be noted that the patent here in suit was allowed by the Patent Office through inadvertence, and that the Patent Office **did not cite** the following important prior patents and publications which are here before the Court:

Exhibit F-3	Patent No. 116,094	[R. 195]
Exhibit F-8	Patent No. 1,114,228	[R. 200]
Exhibit F-12	Patent No. 1,481,662	[R. 204]
Exhibit F-13	Patent No. 1,602,601	[R. 205]
Exhibit F-16	Patent No. 1,712,383	[R. 208]
Exhibit F-17	Patent No. 1,754,986	[R. 209]
Exhibit F-18	Patent No. 1,776,755	[R. 210]
Exhibit F-19	Patent No. 1,785,770	[R. 211]
Exhibit F-21	British patent No. 2,257	[R. 213]
Exhibit F-27	“History of Military Pyrotechnics”	[R. 217]

This Court has repeatedly held that the presumption is overcome under such circumstances:

“The presumption of validity which attends the issuance of Letters Patent by the Patent Office is overcome in this case by the clear evidence of anticipation in the prior art which was not cited or considered by the Patent Office when the application for appellant’s

patent was passed on. See *Elliott & Co. v. Youngstown Car Mfg. Co.*, 181 Fed. 345 (C. C. A. 3); *American Soda Fountain Co. et al. v. Sample*, 130 Fed. 145 (C. C. A. 3)."

*Mettler v. Peabody Engineering Corporation, et al.*, 77 F. 2d 56 (C. A. 9).

See also:

*McClintock v. Gleason et al.*, 94 F. 2d 115 (C. A. 9);

*Stoody Co. v. Mills Alloys Inc.*, 67 F. 2d 807 (C. A. 9);

*Market Soda Fountain Co. v. Sample*, 130 Fed. 145 (C. A. 9).

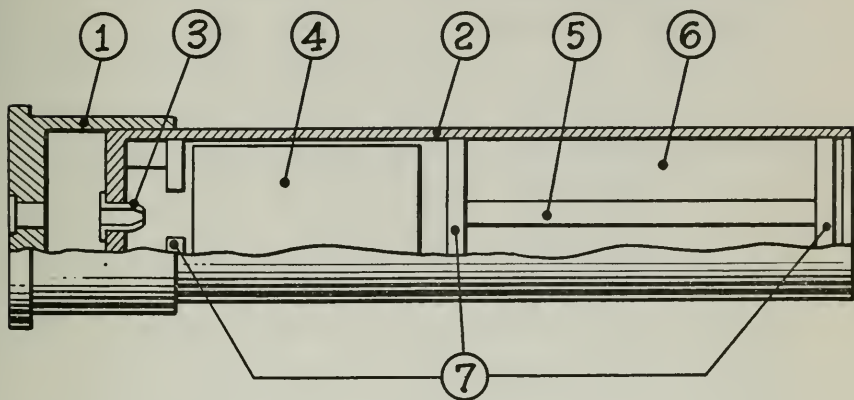
The analysis of the prior art, not cited by the Patent Office, conclusively shows that the patent in suit **lacks invention**. Findings and conclusions which are contrary to the facts and established rules of law cannot be permitted to stand.

## THE EVIDENCE IN THIS CASE COMPELS JUDGMENT OF INVALIDITY.

Shells or ammunition capable of being fired to a height, to there eject a flare suspended from a parachute, have been known since 1864 [see Deft. Ex. F-1, R. 193, patent No. 41,173]. There is no patentable novelty in this general combination of elements.

Plate I attached hereto shows the construction of a parachute flare of the type charged to infringe and identifies the prior expired patents which show the elements. Although a number of prior patents are referred to, an examination of only two or three will convincingly show that the patent in suit lacks invention.

ALL PARTS, IN SAME RELATION, FOR SAME PURPOSE, ARE SHOWN IN PRIOR PATENTS.



(1) Cartridge with percussion cap, shown in Exhibits F-6, F-14, F-15, F-16, F-17, F-18, F-22 [R. 198, 206, 207, 208, 209, 210 and 214].

(2) Tubular shell or case with delay fuse in bottom, shown in Exhibits F-15, F-16, F-17, F-18 [R. 207, 208, 209, 210].

Tubular shell made of one piece of metal, shown in Exhibits F-3, F-4, F-14, F-21 [R. 195, 196, 206, 213].

(3) Eyelet with flange on bottom of shell, shown in Exhibits F-3, F-18, F-19 [R. 195, 210, 211].

(4) and (6) Flare and parachute in a projectile shell, shown in Exhibits F-1, F-2, F-9, F-13, F-16, F-17, F-18, F-19 [R. 193, 194, 201, 205, 208, 209, 210, 211].

(5) Thrust stick in parachute, shown in Exhibit F-18 [R. 210].

(4) (5) (6) and (7) in combination within shell (2), shown in Exhibits F-13, F-16, F-17, F-18, F-19, F-22 [R. 205, 208, 209, 210, 211, 214].



Driggs and Faber, the patentees of the patent in suit, had a number of similar patents (all expired) which were **not cited** by the Patent Office in allowing the patent in suit. These are all part of Defendant's Exhibit F [Vol. II of Record]:

Exhibit F-15	No. 1,712,382	[R. 207]
Exhibit F-16	No. 1,712,383	[R. 208]
Exhibit F-17	No. 1,754,986	[R. 209]
Exhibit F-18	No. 1,776,755	[R. 210]
Exhibit F-19	No. 1,785,770	[R. 211]

(1) Cartridges, made of a single piece of metal, with an integral bottom, such bottom having a hole in which the percussion cap is mounted, are shown in all of these patents. In Exhibit F-15 for example, see Figs. 3 and 5, which show a one-piece case with an annular groove i', which permits the shell to be used in the muzzle loading gun. The patent states "The cartridge case may be cylindrical throughout \* \* \*" instead of being provided with the enlarged forward portion [p. 1, column 2, lines 108 ff]. Substantially the same construction is shown in Fig. 1 of Exhibit F-16, Fig. 5 of Exhibit F-17, and Fig. 1 of Exhibit F-18.

(2) A shell or case with a delay fuse (3) in the bottom of the case is shown in these patents. In each instance the shell or case is held in the cartridge.

In patent No. 1,712,383 [Exhibit F-16] it is stated that the shell or container (in which the parachute and flare are carried) may be made of aluminum.

"This cylinder D may be made of aluminum, bakelite, cardboard or other suitable material." [P. 2, lines 30-32.]



In patent No. 1,754,986 [Exhibit F-17] the shell is identified as “\* \* \* the cylindrical container C which is preferably made of aluminum \* \* \*” [p. 2, lines 15-17].

The delay fuse is indicated at N in Exhibit F-17 and as an eyelet E' in Exhibit F-18. In Exhibit F-19 it is in the form of a flanged eyelet 10, identical in shape to that used in the patent in suit. In each instance, the delay fuse is in the bottom of the shell, and **performs the same function in the same position between the same parts** as in the patent in suit.

- (5) The use of shims or sticks in the parachute compartment of the container or shell (2) in order to prevent the parachute from being compressed or wadded when it is being ejected from the container is shown in Exhibit F-16 [see shims N, described on p. 2, lines 77-81 and 111-120]. In Exhibit F-18, the stick or rod M is clearly shown in Fig. 1.

The **entire contents** of the container, including flare candle (4), stick (5), parachute (6) and suitable pieces of felt wadding (7), as well as the cable connecting the parachute and flare candle, end closure and charge of powder for ejection of the contents, are shown in these prior patents in the same relationship, and for the same purposes as in the patent in suit. **There is no invention in these contents, according to the testimony of Driggs, as admitted by plaintiff.**

“A. ‘1. That Louis L. Driggs, Jr., one of the alleged inventors of patent No. 1,947,834 in suit herein, testified under oath in the case of The Kil-



gore Mfg. Co. *et al.* v. Triumph Explosives, Inc., *et al.*, in which case patent No. 1,947,834 was in issue, as follows:

“The Court: There is nothing new, is there, in the arrangement of the contents of the projectile? That is to say, this method of arranging the powder and connecting fuses and protecting certain parts by the felt washer and including a parachute and all that, is there anything new in that?

The Witness: Not in the projectile itself, no, basically.”

\* \* \* \* \*

“Q. Is it your contention that there is anything new in the arrangement or in the combination of a projectile containing those particular contents, with a cartridge case containing a propelling charge for such a projectile, being adapted to be projected from the cartridge case when the propelling charge is exploded? A. No.”

\* \* \* \* \*

(Answer) “Plaintiff admits that Louis L. Driggs, Jr., testified as quoted in paragraph 1 of defendant’s Requests for Admissions \* \* \*.”” [Deft. Ex. G, R. 161 and 162.]

The uncontrovertible evidence of these prior publications shows that every element has been used in **same combination for the same purpose**. The patent in suit must be invalid.

The record conclusively proves that each of the elements is old and the entire combination is old. In view of the showings of the prior patents and plaintiff’s admissions, it

is inconceivable how the Trial Court could state that the patentees of the patent in suit

“\* \* \* produced a new combination \* \* \*  
[Finding 9, R. 67] or that the claims are directed  
“\* \* \* to a combination that is not only new  
and useful, but embodies invention and constitutes  
patentable subject matter.” [Finding 13, R. 68.]

The above findings as to a “new” combination are directly contrary to plaintiff’s own admissions:

“The Court: So everything that is described in the patent in suit in combination has been previously claimed in combination, has it not, by these same inventors—

Mr. Schmieding: That’s right, your Honor.

\* \* \* \* \*

The Court: The combination has been the same, except that the shell has been in more than one piece?

Mr. Schmieding: That’s right.” [R. 145.]

PLAINTIFF IS CHALLENGED TO POINT TO A SINGLE NEW ELEMENT IN THIS COMBINATION; PLAINTIFF IS CHALLENGED TO POINT TO A SINGLE INSTANCE OF INVENTION.

Plaintiff cannot argue that there is invention in making the container or shell 2 out of one piece of metal, because this shell (2) with its delay fuse (3) was described in claims 1, 2 and 3 of the patent in suit and these claims were properly held invalid by the Trial Court.

Claim 1, held invalid, reads as follows:

“In combination, a shell comprising a base and side wall of one piece of drawn metal, said base having an aperture, and a tubular eyelet having a shoulder

inserted in said aperture, the shoulder thereon resting on the outside of the base of the shell.”

Plaintiff did not appeal from this holding and has constructively disclaimed a one-piece shell. Two years before the trial of this case plaintiff admitted that there was no invention by stating:

“Plaintiff admits that prior to the earliest date of invention by Driggs and Faber, that there was described in printed publications and known to others in the United States—

(d)—a projectile case having a base and substantially cylindrical side walls, of one piece of metal, the base being provided with an aperture.”  
[Exhibit G, B5(d), R. 172.]

The entire patent is invalid and void for lack of invention.

### **PLAINTIFF'S ADMISSIONS COMPEL HOLDING CLAIMS 10 AND 11 INVALID.**

Two years before the trial of this case, plaintiff made admissions, in answer to defendant's requests for admissions and interrogatories, which admissions conclusively show that all of the claims of the patent in suit were invalid for lack of invention. These admissions made by plaintiff under oath and obtained under Rule 36 F. R. C. P., were admitted in evidence [R. 90] in the course of judicial proceedings.

“Facts judicially admitted are facts established not only beyond the need of evidence to prove them, but beyond the power of evidence to controvert them.”

*Hill v. Federal Trade Commission*, 124 F. 2d 104,  
106 (C. A. 5);

*Oscanyan v. Arms Co.*, 103 U. S. 261, 263.

This Court is respectfully urged to read the admissions, since the entire case can be determined on this evidence alone.

The effect of the admissions made by plaintiff upon the flare allegedly covered by claim 11 is graphically illustrated on the appended plate, wherein II illustrates the flare of claim 11. Claim 11 is applied directly, reading upwardly from the bottom.

Driggs, one of the inventors, **admitted** that there was **no invention** in the contents or arrangement of the contents or arrangement of the contents of the shell [Exhibit G, Admission A-1; R. 161, 162].

Since there is no invention in the contents, let us eliminate the contents and go to plate III where the contents have been left out.

Plaintiff has **admitted** that there is **no invention** in the combination of a long projectile and a short cartridge [Exhibit G; see A.8(c); R. 168] [shown in many prior patents and publications; see for example Exhibits F-6 R. 198; F-13, R. 205; K-1].

Since there is no invention in this combination, let us eliminate the cartridge [which is also old as shown by many prior patents, Exhibits F-6, R. 198; F-13, R. 205; F-14, R. 206; F-17, R. 209; F-18, R. 210; F-27, Plate 4a, R. 217] and go to plate IV which is now just an empty container.

Plaintiff admitted that there is **no invention** in making this out of aluminum [Exhibit G, A-5, R. 172, and B-10, R. 173].

Plaintiff had to make this admission because prior expired patents [Exhibits F-16 and F-17] stated that the

# PLAINTIFF'S ADMISSIONS [EXHIBIT G] DEMONSTRATE LACK OF INVENTION AND PROVE INVALIDITY

## CLAIM 11

and detachable closure means for said shell engaging said means for preventing the collapse of the parachute.

and means to prevent the collapse of said parachute

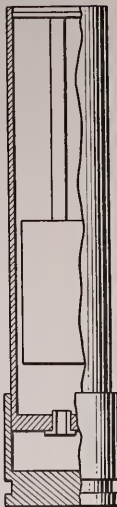
a flare and a parachute in said shell,

a telescopically-arranged shell mounted therein having a relatively heavy integral base and thin side walls,

a fuse in the base of said shell communicating with the propelling charge of the cartridge case on one side and with an expelling charge in the shell on the other side,

11. In combination, a cartridge case having a base with an annular groove, a propelling charge chamber and a fuse mounted therein, said base carrying side walls,

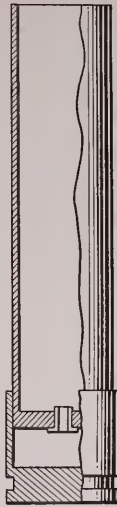
II



No invention in contents or arrangement of contents [Exhibit G, R. 161-162]

No invention in combination of short cartridge and long projectile [Exhibit G, A8c, R. 168; also B8, R. 175]

III



No invention in one-piece projectile [Exhibit G, B5d, R. 172]

Nor in projectile with eyelet [Exhibit G, A6, R. 169]

Nor in drawing from metal [Exhibit G, B10, R. 173]

Nor in making from aluminum [Exhibit G, A5 and C7, R. 172-173]

IV



(This shell is defined in claims 1-3, which have been held invalid)

SINCE THERE IS LACK OF INVENTION, CLAIMS 10 AND 11 ARE INVALID



projectile or cylindrical container is “preferably made of aluminum.” [P. 2, line 16, R. 209.]

Plaintiff admitted that there was **no invention in a one-piece projectile** [Exhibit G, B-5d, R. 172]:

“Plaintiff admits that prior to the earliest date of invention by Driggs and Faber, that there was described in printed publications and known to others in the United States.

“(d)—a projectile case having a base and substantially cylindrical side walls, of one piece of metal, the base being provided with an aperture.’ ”

Plaintiff admitted that there was no invention in a tubular projectile with an eyelet in the bottom [Exhibit G, A-6, R. 169]:

“A. 6. That more than two years prior to September 19, 1931, there was publicly used and sold in the United States—

(a)—a tubular projectile having a transversely extending bottom or base, a port in such bottom or base, and a tubular eyelet inserted in such port, the eyelet having a flange resting on the outside of the base or bottom;

(b)—the tubular projectile having a transversely extending bottom or base, a port in such bottom or base, and a tubular eyelet inserted in such port, the eyelet having a flange resting on the outside of the base or bottom, the eyelet having a reduced inner end and a fuse powder in the eyelet.

(Answer) *Plaintiff admits the allegations set forth in paragraph 6 of Defendant's Request for Admissions.*”



By these admissions plaintiff has eliminated the entire device from the field of novelty—there is nothing left. A VOID—emptiness.

IN VIEW OF THESE ADMISSIONS THE FINDINGS OF THE TRIAL COURT ARE CONTRARY TO THE EVIDENCE. Since the record conclusively shows that there is no invention, it is a travesty upon justice to have finding 9 state that the patentees “\* \* \* devised something new and useful. They produced a new combination of old elements \* \* \*.” Findings 9 and 13 are contrary to the admissions and to the showings of the prior art, and the judgment of the lower court must be reversed.

This Court has had occasion to previously reverse the same Trial Court because of an erroneous holding of validity where there was no invention and had clearly stated:

“\* \* \* As stated by this circuit in *Keszthelyi v. Doheny Stone Drill Co., et al.*, 59 F. 2d 3, 8, ‘A mere difference or change in the mechanical construction in the size or form of the thing used, in order to obviate known defects existing in the previous devices, although such changes are highly advantageous, and far better and more efficacious and convenient, does not make the improved device patentable. In order to be patentable, it must embody some new idea or principle not before known. *It must, as before stated, be a discovery, as distinguished from mere mechanical skill or knowledge.*’

\* \* \* \* \*

“Even though the functions performed by the combination be new and useful, this does not make the device patentable, *for it must also be invention*

*and/or discovery. There must be ingenuity over and above mechanical skill. These features have been used in a similar fashion in earlier patented devices.”*

*Schick Service, Inc. et al. v. Jones, etc., 173 F. 2d 969.*

In view of the above admonition and the uncontrovertible admissions by plaintiff, this Court is compelled to again reverse the Trial Court and hold that claims 10 and 11 are invalid.

### **THERE IS NO INVENTION IN MAKING A CONTAINER OR SHELL FROM ONE PIECE OF METAL.**

Is it invention to substitute a one-piece shell for a two-piece shell in an old combination?

This issue is controlling, since plaintiff stated that if there was an invention it lay in making the container or shell from one piece of metal.

“The Court: Do you care to state what the new element is?

Mr. Schmieding: Yes. I believe I did that in my answer to his admission. I said the new element was a one-piece projectile shell including relatively thin side walls and a heavy base.” [R. 86.]

\* \* \* \* \*

“The Court: So what troubles me here, while we can talk about a combination and limiting a device to the precise combination taught in the patent, when we analyze it we are saying that making two pieces of one is an invention.

Mr. Schmieding: That is right. \* \* \*” [R. 159.]

This simple issue can be answered only in the negative in view of the record and common knowledge. The record shows that the patentees of the patent in suit were not the first to make a one-piece container or shell. A sworn admission of fact in evidence in this case cannot be disregarded, to wit:

“Plaintiff admits that prior to the earliest date of invention by Driggs and Faber, that there was described in printed publications and known to others in the United States—

“(d)—a projectile case having a base and substantially cylindrical side walls, of one piece of metal, the base being provided with an aperture.” [Exhibit G, R. 172.]

The Trial Court was bound by this admission, but disregarded it. The facts so admitted are substantiated by documentary evidence. Exhibit F-14 [R. 206] shows a one-piece projectile case; the projectile cases of Exhibit F-18 [R. 210] were made out of aluminum by plaintiff [R. 141].

Since a one-piece projectile case or container was old, there was no invention involved in substituting such one-piece container for a two-piece container in an old combination.

One-piece containers, whether they are cartridge cases, shells, or ordinary kitchen pots, have and have had integral bottoms and are not new; the Court cannot close its eyes to such commonplace articles.

“In deciding whether the patent covers an article the making of which requires invention, we are not

required to shut our eyes to matters of common knowledge or things in common use.”

*King v. Gallun, et al.*, 109 U. S. 99, 101, 27 L. Ed. 870.

The antiquity of one-piece shells, cases and cartridges in the munitions field is evidenced by judicial determinations of which this Court has notice. In 1884 the Supreme Court of the United States determined that one-piece cartridge shells with a flanged bottom (for breach-loading guns) were old and not inventive.

*Cartridge Co. v. Cartridge Co.*, 112 U. S. 624, see pp. 629, 630.

*Hubbell v. U. S.*, 179 U. S. 77, is of interest because it deals with ammunition. The patent there in suit related to cartridges and the Supreme Court pointed out that

“Breech loading metallic cartridges were not new  
\* \* \*.” (P. 83.)

even in 1878. In 1878 the cartridges or shells described by the Supreme Court were made of one piece of metal:

“The flange and head of the metallic case are solid, all in one piece.” (P. 80.)

The description in this old Supreme Court case is applicable here:

“This cartridge is a hollow metallic shell, rimmed around the base, with a pocket in the exterior of the center of the base; through the center of the top of this pocket, supposing the cartridge to be stood upon its base or closed end, is pierced a single aperture or hole to carry the fulminate flame to the black powder chamber. \* \* \*” (P. 84.)

There is no invention involved in making the bottom of a container or shell in one piece with the side walls. In *Howard v. Detroit Stove Works*, 150 U. S. 164, the court considered a stove whose body was a cylinder with an inwardly extending flange at the bottom, this flange supporting a grate. (In this case we have a cylindrical container having an inwardly extending bottom flange surrounding the delay fuse, the flange forming a bottom supporting the powder, parachute flare, etc.) The Supreme Court held that it was not invention to make the grate or bottom integral with the side walls, stating:

“\* \* \* *it involves no invention to cast in one piece an article which had formerly been cast in two pieces and put together.*” (150 U. S. 170.)

The great weight of authority holds that making an article from one piece when it was formerly made of two, is only mechanical skill and not invention.

“The single question herein is whether this new construction ‘involved the exercise of the inventive faculty’. The prior art shows and the patent admits that such a lining in two pieces was old. That it does not involve invention merely to make such a lining in one piece is well settled. *Howard v. Detroit Stove Works*, 150 U. S. 164; *Standard Caster & Wheel Co. v. Caster Socket Co.*, 113 Fed. 162, 51 C. C. A. 109. Nor would the mere fact that the one-piece device was cheaper or more durable constitute invention when *such results were merely such ordinary consequences of dispensing with joints as would naturally be anticipated by the workman.* *Manufacturing Co. v. Holtzer*, 67 Fed. 907, 15 C. C. A. 63. In *Standard Caster & Wheel Co. v. Caster Socket Co.*, *supra*, the court says:



‘In *Manufacturing Co. v. Holtzer*, 67 Fed. 907, 15 C. C. A. 63, the Circuit Court of Appeals for the First Circuit held that *the right to improve on prior devices by making solid castings in lieu of attached parts is so common and universal in the arts as to cast a heavy burden upon any one claiming patentability for such an improvement to show special reasons in support of his claim.*’ ”

*General Electric Co. v. Yost Electric Mfg. Co.*, 139 Fed. 568, 570 (C. A. 2).

“This is not to overlook the insistence for appellee that it was invention to convert the rectangular plate with a perforated flange mechanically attached into a single structure. *It is, however, settled that simply to unite two parts into an integral construction does not constitute invention* (Howard v. Detroit Stove Works, 150 U. S. 164; *Standard Caster & Wheel Co. v. Caster & Socket Co.*, 113 Fed. 162, 166, 51 C. C. A. 109); and this principle is especially applicable here, since the two parts so converted into a unitary structure could have no different relation to each other, or to other perforated parts with which they might be combined in toy building, from that which they bore when they were simply mechanically attached.  
\* \* \* It must follow that the patent is void because of the lack of invention.”

*Wagner et al. v. Meccano Limited*, 246 Fed. 603, 608 (C. A. 6).

The general rule was well stated by the Court in *Standard Caster & Wheel Co. v. Caster Socket Co.* (C. A. 6), 113 Fed. 162 at 166, as follows:

“The conclusion from all cases must be that mere making in one piece of a device formerly made in two parts mechanically attached is not invention.”

To the same effect see:

*James Heddon's Sons v. American Fork & Hoe Co.*,  
148 F. 2d 230 (C. A. 6);

*Cleveland Punch & Shear Works Co. v. E. W. Bliss  
Co.*, 145 F. 2d 991 (C. A. 6);

*Enterprise Railway Equipment Co. v. Pullman  
Standard Car Mfg. Co.*, 95 F. 2d 17 (C. A. 7);

*National Battery Co. v. Western Molded Products  
Co.*, 39 Fed. Supp. 954 (D. C. Cal.), affirmed 132  
F. 2d 510 (C. A. 9).

More recently it was stated:

*"In making a metal container the choice of an in-  
tegral closure or a separate one gripped tightly by  
the walls was a mechanic's choice."*

*Ray-O-Vac Co. v. Goodyear Tire & Rubber Co.*,  
45 Fed. Supp. 927, 932, affirmed by the Su-  
preme Court, stating:

*"The choice was one between alternative means  
obvious to any mechanic; it did not have the quality  
of invention."* (299 U. S. 98.)

This general rule of law is clearly applicable here. The prior patents show parachute-type flares in which there are, in combination, a cartridge case with its percussion cap and black powder and a projectile shell or container, such container having a bottom, a delay fuse in such bottom and carrying an expelling charge, flare and parachute within the container. Plaintiff cannot deny this. This old combination is clearly shown in Exhibits F-17 and F-18 [R. 209 and 210].

There is no invention involved in substituting a container with an integral unitary bottom for the two-piece



container of old patents such as Exhibits F-16, F-17 and F-18 [R. 208, 209, 210].

The elements are still in the **same relationship**; the one-piece container still functions in the same way; it still carries the flare and parachute. There is **no new or different relationship** between the projectile and the base cartridge or between the projectile or container and its contents. The percussion cap performs its old and normal function; the black powder performs its old and normal function of shooting the projectile into the sky; the height to which it is shot depends upon the kind and amount of powder used. (Note: the patent in suit does not state what powder or how much to use.) The flare and parachute will be ejected from the container by the ejection charge in the same way as in the prior patents Exhibits 16, 17, 18 and others; the color of the flare is not influenced by the construction of the container; the delay fuse acts in the **same way** whether the bottom of the container is integral with its walls or attached to the walls in some other manner.

Actually, this admittedly old combination [R. 145] is only an aggregation of old elements.

*“So long as each element performs some old and well-known function, the result is not a patentable combination, but an aggregation of elements.”*

*Richards v. Chase Elevator Co.*, 158 U. S. 299, 302.

“The results must be a product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements.”

*Grinnell Washing Machine Co. v. Johnson Co.*, 247 U. S. 426, 62 L. Ed. 1196, 38 S. Ct. 547, 549.

“If several old devices are so put together as to produce even a better machine or instrument than was formerly in use, but each of the old devices does what it had formerly done in the instrument or machine from which it was borrowed and in the old way, without uniting with other old devices to perform any joint function, it seems that the combination is not patentable. *Hailes v. Van Wormer*, 20 Wall. (87 U. S.) 353, 22 L. Ed. 241; *Reckendorfer v. Faber*, 92 U. S. 347, 23 L. Ed. 719.”

*Brinkerhoff v. Aloe*, 146 U. S. 515, 516, 36 L. Ed. 1068, 13 S. Ct. 221.

Followed in:

*Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549;

*Bailey v. Sears & Roebuck*, 115 F. 2d 904 (C. A. 9).

The substitution of a one-piece container for an older, two-piece container is not inventive. It is not invention to substitute aluminum for copper or brass in making such container.

“A substitution of one material with known characteristics for another material does not rise to the dignity of invention.”

*U. S. Appliance Corp. v. Beauty Shop Supply Co., Inc.*, 121 F. 2d 149 (C. A. 9).

Also to the same effect see:

*Heath v. Frankel*, 153 F. 2d 369 (C. A. 9);

*Kalich v. Paterson Pacific Parchment*, 137 F. 2d 649 (C. A. 9);

*Evr-Kleen Seat Pad Co. v. Firestone Tire & Rubber Co.*, 118 F. 2d 600.

It is to be remembered that the claims here in issue, claims 10 and 11, are **combination claims**. If the one-piece container was assumed to be new

“\* \* \* and the claims were construed to include it, *the patent would nevertheless be invalid* for overclaiming the invention by including old elements, unless, together with its other old elements, the extension (container here) made up a new combination patentable as such.”

*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 at 150.

The above case is particularly applicable here, and the following language is directly in point:

“Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. \* \* \* A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly.

\* \* \* \* \*

“\* \* \* The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components.” (340 U. S. at 152, 153 and 154.)

The only purported novelty is a “mechanic’s choice” and the only advantages are “merely such ordinary

consequences of dispensing with joints as would naturally be anticipated by the workman." Such commonplace mechanical skill is not invention. Claims 10 and 11 are invalid.

The general rule that invention must be present and that a claim is invalid if invention is not defined, is well stated in the following authorities:

*"There must be ingenuity over and above mechanical skill."*

*Schick Service Inc. v. Jones*, 173 F. 2d 969 (C. A. 9);

*Keszthelyi v. Doheny Stone Drill Co.*, 59 F. 2d 3, 8 (C. A. 9);

*Toledo Pressed Steel v. Standard Parts Inc.*, 307 U. S. 350.

"\* \* \* Assuming for the moment that the Lane tool has such advantages it would not on that account be patentable. It is not sufficient that the device be new and useful. It must also be an invention or discovery."

*Lane Wells Co. v. M. O. Johnston Oil Field Service*, 181 F. 2d 707 (C. A. 9).

"\* \* \* Under the statute (35 U. S. C. §31; R. S. §4886) the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. *Thompson v. Boisselier*, 114 U. S. 1, 11. Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. *Hicks v. Kelsey*, 18 Wall. 670; *Slawson v. Grand Street R. R. Co.*, 17 Otto 649; *Phillips v. Detroit*, 111 U. S. 604; *Morris v. McMil-*

lin, 112 U. S. 244; Saranac Automatic Machine Corp. v. Wirebounds Patents Co., 282 U. S. 704; Honolulu Oil Corp. v. Halliburton, 306 U. S. 550. 'Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not patentable.' Reckendorfer v. Faber, 2 Otto 347, 356-357. The principle of the Hotchkiss case applies to the adaptation or combination of old or well known devices for new uses. Phillips v. Detroit, *supra*; Concrete Appliances Co. v. Gomery, *supra*; Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co., *supra*; Electric Cable Joint Co. v. Brooklyn Edison Co., 292 U. S. 69; Altoona Public Theaters, Inc. v. American Tri-Ergon Corp., *supra*; Textile Machine Works v. Louis Hirsch Textile Machines, Inc., 302 U. S. 490; Toledo Pressed Steel Co. v. Standard Parts, Inc., 307 U. S. 350."

*Cuno Engineering Corp. v. The Automatic Devices Corp.*, 314 U. S. 84.

In order to have invention

"\* \* \* More must be done than to utilize the skill of the art in bringing old tools into new combinations."

*Cuno* case, 314 U. S. 84, citing: *Hailes v. Van Wormer*, 20 Wall. 353, 368; *Pickering v. McCullough*, 14 Otto 310, 318; *Thatcher Heating Co. v. Burtis*, 121 U. S. 286, 294; *Concrete Appliances v. Gomery*, 269 U. S. 177 at 184-185; *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175, 186; *Carbice Corp. v. American Patents Dev. Co.*, 283 U. S. 420.

It is submitted that the Trial Court ignored the facts and disregarded the law. The evidence and the authorities compel holding claims 10 and 11 invalid.



## THE PRIOR PATENTS CONCLUSIVELY SHOW LACK OF INVENTION.

Plate I of this brief has shown that all of the parts of the claimed device have been shown in the prior patents and publications, for the same purpose and in the same relationship.

Plates VI to IX demonstrate that one prior patent suggests and teaches the changes in form and deprives the patent in suit of any semblance of invention.

Plate VI illustrates a parachute flare described in **expired** patent No. 1,712,383 [Exhibit F-16, R. 208] formerly owned by plaintiff and held **invalid** by the 4th Circuit at 128 F. 2d 444. This flare was for use in a short-barreled muzzle-loading hand gun. The case has the "base with an annular groove" which is called for in claims 10 and 11.

The prior, invalid patent Exhibit F-16 states that the case may be of uniform diameter throughout, and therefore the device can be made of the form shown in Plate VII without the exercise of invention.

Moreover, as shown in Plate VIII, the case can be short. There is no invention involved in making a case longer or shorter. Changes in length or degree are not inventive.

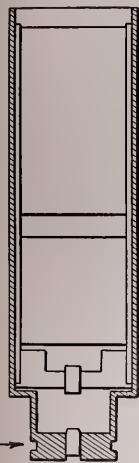
The container or projectile can be made of aluminum, in accordance with the teachings of the expired, invalid patent Exhibit F-16.

In Plate VIII we have a device that answers all requirements of claims 10 and 11 except that the bottom of the container is attached to the walls and is not integral with the walls.



CHANGES IN FORM, SUGGESTED BY PRIOR ART, ARE A MECHANIC'S CHOICE AND NOT INVENTIVE

VI  
Shown in Exhibit F-16  
[R. 208]



Case "may be in the form of a single cylinder from end to end" [page 1, line 25 of Exhibit F-16]

Groove to permit use in muzzle-loading pistol of Exhibit F-15 [R. 207]

VII



Container cylinder "may be made of aluminum" [page 2, line 30 of Exhibit F-16, R. 208]

Case may be short, as in Exhibit F-18 [R. 210]

VIII



Bottom of container may be integral. No invention in one-piece projectile [R. 172]

IX



This shape evolved by Clauser and not Driggs and Faber [R. 135]

"In making a metal container the choice of an integral closure or a separate one gripped tightly by the walls was a mechanic's choice."

(45 F. Supp. 927, 932) Affirmed by Supreme Court as

"\* \* \* no more than the choice of mechanical alternatives  
\* \* \*"

(*Goodyear Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 278.)



But plaintiff had admitted that projectiles with integral bottoms were not new [R. 172]. Therefore the substitution of the one-piece container or projectile of Plate IX for the two-piece container of Plate VIII is not and cannot be invention.

It is to be noted that by making the changes in shape or form (and without any changes in function or result) we end up with a flare which would have been an infringement of expired patent Exhibit F-16.

Plaintiff is now attempting to extend its monopoly over the same device by claiming that it also infringes the patent in suit here. Plaintiff is stating that what is in the public domain is covered by claims 10 and 11 of the patent in suit.

It is submitted that any member of the public has the right to make flares like Plate VIII or with a container having an integral bottom. The mechanic cannot be deprived of his choice of common, alternative methods of construction.

Claims 10 and 11 are invalid for anticipation and lack of invention.

PLAINTIFF CANNOT POINT TO A NEW RESULT. THE OLD COMBINATION IS INVALID.

In a frantic effort to salvage claims 10 and 11, plaintiff fruitlessly attempted to discover some novelty in result, since there was no novelty in the combination of elements defined by the claims. These tactics caused delay and confused the Trial Court, but cannot save an invalid claim, since a patentee is bound by the language of his claim.

Claims "measure the invention" and set the limits beyond which the patentee cannot go.

*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 419;

*General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 369;

*Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274, 278.

"Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial."

*Water Meter Co. v. Desper*, 101 U. S. 332, 337.

Claims 10 and 11 here on appeal are combination claims; they must be subjected to close scrutiny. The recent expressions of the Supreme Court, in the light of the facts here of record, show that claims 10 and 11 are invalid, because each element has been previously used in the same

arrangement, for the same purpose, and plaintiff cannot point to a single additional or different function.

“\* \* \* The concept of invention is inherently elusive when applied to combination of old elements.

\* \* \* \* \*

“\* \* \* The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. \* \* \* This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test.

\* \* \* \* \*

“Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.”

*Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation*, 340 U. S. 147, 151, 152.

“Patents on machines which join old and well-known devices with the declared object of achieving new results, or patents which add an old element to improve a pre-existing combination, easily lend themselves to abuse. And to prevent extension of a patent’s scope beyond what was actually invented, Courts have viewed claims to combinations and improvements or additions to them with very close scrutiny. *Cf. J. Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549-51.”

*Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1.

This Court has repeatedly held combination claims invalid.

*“There was no new function performed by the combination. The function performed was merely to indicate the location of the rotor blades, as in prior devices. Hence it was not patentable as a combination of old elements. (Citing cases.) What we have here is an aggregation of parts assembled by mere mechanical skill.”*

*Bailey v. Sears, Roebuck & Co.*, 155 F. 2d 904 (C. A. 9), cert. denied 314 U. S. 616.

To the same effect see:

*Goodman v. Paul E. Hawkinson*, 120 F. 2d 167 (C. A. 9);

*Magarian v. Detroit Products Co.*, 128 F. 2d 544 (C. A. 9);

*Mettler v. Peabody Engineering Co.*, 77 F. 2d 56 (C. A. 9);

*Grinnel Washing Machine Co. v. Johnson Co.*, 247 U. S. 426, 438.

Plaintiff's expert attempted to dramatize the trial by creating the impression that the patent related to a combination of a sinking ship, a life raft, a parachute flare and a rescue vessel twenty-five miles away. An interesting picture, but it has nothing to do with the merits of the patent in suit.

Plaintiff tried to state that its flares are shot 150 feet or more into the air; prior patent No. 1,785,770 [Exhibit F-19, R. 211] states that the parachute is expelled “Say when the projectile is **one hundred and fifty feet** in the air, \* \* \*.” [P. 2, lines 1 and 2.] Obviously, the height



to which the flare is shot depends upon the kind and amount of powder used, and the use of more or less powder is a matter of degree and not invention.

“The Court: You would not claim any invention after putting powder in there in order to discharge the projectile at a greater height?

Mr. Schmieding: No.” [R. 159.]

Plaintiff’s expert stated that one advantage of the one-piece projectile container lay in that there was less possibility of leakage of gases or flash of fire through cracks or crevices during firing [R. 116]. In defining what he meant by a crevice or crack he stated:

“That is just simply an aperture due to *faulty mechanics* or construction which would permit the passage of a spark” [R. 117.]

Since 1878 cartridge manufacturers have known that such “faulty mechanics” can be overcome by a one-piece shell. (See *Hubbell v. U. S.*, 179 U. S. 77 at 80, 84 and *Cartridge Co. v. Cartridge Co.*, 112 U. S. 624.) Actually, as long as the bottom of the projectile or container is well connected, it will function.

“Q. (By Mr. Miketta): Irrespective of what material we are using, Dr. Clauser, if we had a projectile shell in the form of a metallic tube, and you attached a *separate bottom* on that tube, either by screwing it on or welding it on, as long as you made sure that you had a *tight joint* between that bottom and the walls of that projectile shell, *wouldn’t that answer the requirements and prevent flash?* A. **It would** as long as you get it to the point where you get it absolutely tight.” [R. 138.]

The only advantages then, are

“\* \* \* merely such ordinary consequences of dispensing with joints as would naturally be anticipated by the workman.”

*General Electric Co. v. Yost Electric Mfg. Co.*, 139 Fed. 568, 570 (C. A. 2).

Even thirty years ago it was known that a lighter, stronger and cheaper article could be made by making it out of one piece instead of two. Invention, which must involve more than the expected skill of the artisan, cannot be predicated upon such flimsy ground.

Realizing that the one-piece container was not adequate basis upon which the patent could be sustained, plaintiff's counsel and his expert insisted that the gradually tapered shape of the eyelet delay fuse was new [R. 132], stating that dome-shaped eyelets were old, but

“\* \* \* they do not function the same as this tapered eyelet with the elongated restriction.” [R. 132.]

Clauser insisted that this tapered shape was “very very important” [R. 121]; the device would not function with any other shape [R. 133].

This argument shows that the patent in suit is **invalid** because

(1) The shape of the eyelet was developed by experience of Clauser while he was with Triumph Explosives, long prior to the filing of the patent in suit [R. 134-135]. This shape was not invented by Driggs and Faber.

(2) The patent in suit and claims 10 and 11 do **not call for a tapered eyelet**. The claims are invalid because they fail to define the purported invention.

“\* \* \* Congress requires of the applicant ‘a distinct and specific statement of what he claims to be new, and to be his invention.’ Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must ‘inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.’ The claims ‘measure the invention.’”

*General Electric Co. v. Wabash Appliance Corp., et al.*, 304 U. S. 364 at 369.

Claims have been held indefinite for these reasons in many cases, among them the Supreme Court cases mentioned hereinabove, as well as:

*United Carbon Co. v. Binney & Smith Co.*, 317 U. S. 228;

*Kruger v. Whitehead*, 153 F. 2d 238 (C. A. 9);

*Timken Detroit Axle Co. v. Cleveland Steel Products Co.*, 138 F. 2d 267 (C. A. 6); cert. den. 326 U. S. 725; rehearing den. 326 U. S. 808;

*Waterhammer Arrester Corp. v. Tower*, 156 F. 2d 775 (C. A. 7).

PLAINTIFF IS CHALLENGED to point out wherein the old elements of the old combination described in claims 10 and 11 produce a “new or different function or operation than that theretofore performed or produced by them” as required by all of the authorities, including:

*Lincoln Engineering Co. v. Stewart-Warner Corp.*,  
303 U. S. 545 at 549;

*Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84;

*Toledo Pressed Steel Co. v. Standard Parts, Inc.*,  
307 U. S. 350;

*Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

The only conclusion which can be reached is that the claims of the patent in suit are **invalid for lack of invention, and for aggregation** of parts without the production of different results.

**CLAIMS 10 AND 11 ARE FOR AN INOPERATIVE, INCOMPLETE AGGREGATION OF OLD ELEMENTS.**

The attention of the Court is called to the fact that claim 11 set out in full and illustrated in Plate II is for an incomplete, inoperative assemblage of elements. Claim 10 even more drastically fails to define an operative device, because it leaves out the “detachable closure means.”

Claim 11 does not define a complete flare because:

(1) It does not include a cable to connect the parachute to the flare, nor require the use of gas checks, nor the use of the wooden annulus surrounding the expelling charge in the shell, such annulus being **very**

**important** according to testimony of plaintiff's witness Clauser [R. 119-120].

(2) It does not state how thin the walls of the shell may be, nor how thick the base of the shell should be [Exhibit G, R. 181].

(3) It does not state the kind and amount of powder to be used in the propelling charge; some powders may be sufficiently strong to burst the cartridge and the gun from which it is fired.

(4) It does not require that the delay fuse may have the tapered end deemed **essential** by plaintiff's witness Clauser [R. 121, 132, 133, 134].

Since claims 10 and 11 do not include elements which were represented as "very, very important" or essential to the operation of the device, the Trial Court is in grievous error in holding that the patentees have devised and claimed something "new and useful."

### **CLAIMS 10 AND 11 ARE INVALID BECAUSE THEY CLAIM MORE THAN WAS IN- VENTED.**

If it be assumed, for purposes of discussion only, that Driggs and Faber actually invented a new, specifically tapered delay fuse eyelet, or a one-piece container with an integral bottom, **they did not claim their improvement as such**, and therefore the claims are void and invalid. The applicable rule of law is well stated in the following cases:

"As we said of Gullborg in the Rogers case, having hit upon this improvement *he did not patent it as such* but attempted to claim it in combination with other old elements which performed no new function in his



claimed combination. *The patent is therefore void as claiming more than the applicant invented.* The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.”

*Lincoln Co. v. Stewart-Warner Corp.*, 303 U. S. 545 at 549.

“\* \* \* Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. \* \* \* The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts.”

*Bassick Co. v. Hollingshead Co.*, 298 U. S. 415 at 424-425.

The many prior patents issued to Driggs and Faber show that plaintiff had attempted to cover every minute modification, and thereby prevent competition. The patent in suit was the last of a long line of patents. The patent in suit is a “rehash” of the same subject, as an old and exhausted combination. The above rules of law require that the patent in suit be held invalid.



## DEFENDANT DOES NOT INFRINGE.

The patent in suit had twenty-three claims and twenty-one of the claims (1-9 and 12-23) have been held invalid. This emphasizes the specific and limited character of claims 10 and 11 here on appeal. **Details of construction and limitations appearing in these claims cannot be disregarded**; the construction called for in these claims must be found in defendant's flare, Plaintiff's Exhibit 2 charged to be the infringing device.

Your Honors will note that defendant's flare [Exhibit 2 and Exhibit 25] is designed for use in a breech-loading gun; these flare shells have the common outwardly extending flange or lip at the base which positions the shell within the breech and precludes the insertion of the shell through the muzzle of the gun.

Claims 10 and 11 call for a combination which very specifically defines, as an essential element

**“a cartridge case having a base with an annular groove.”**

It is settled that a claim for a combination must be limited to the particular combination of elements defined in the claim, and all of the elements are material.

*I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429;

*Hubbell v. U. S.*, 179 U. S. 77, 82;

*Schumacher v. Cornell*, 96 U. S. 549, 554;

*Vance v. Campbell*, 66 U. S. 427.

“\* \* \* it is undoubtedly true that the patentees in a suit for infringement must be limited to what is specified in the claims annexed to the specification.”

*Brooks v. Fiske*, 15 How. (56 U. S.) 212, 215;

*Bates v. Coe*, 98 U. S. 31, 38.

Defendant does not use “a base with an annular groove.” Defendant does not infringe.

Claims 10 and 11 are directed to a muzzle-loading shell; defendant does not make muzzle-loading shells. It is impossible to insert defendant’s Exhibit 2 through the muzzle of the gun in which such shells are normally fired.

Counsel for plaintiff admitted during trial that claim 10 covers a muzzle-loading arrangement shown in Fig. 4 of the patent—

“The Court: That is a muzzle-loading arrangement, Fig. 4.

Mr. Schmieding: That is a muzzle-loading arrangement.” [R. 148.]

Plaintiff’s expert, Clauser, and plaintiff’s former president, Hubbard, also defined a shell having an annular groove as a muzzle loader.

“Q. And therefore, Fig. 4 really relates to a muzzle-loading shell which is of the type which you say was used from aircraft? A. Yes, sir, that’s definitely an aerial shell.” [R. 143.]

“Q. When it has the annular groove near the bottom, then it is a muzzle-loading flare? A. That is essentially correct.” [R. 97.]

The annular groove is specifically designed to permit the shell to be used in the pistol of patent No. 1,712,382 [Exhibit F-15, R. 207], which is stated to be a “\* \* \* hand-operated muzzle-loading firearm.” Shells with such annular groove, and without defendant’s flange, **could not be used** in the guns approved by the United States Coast Guard and described on page G-10 of Exhibit E.

It is clear that the limitation “a cartridge case having a base with an annular groove” is an important limitation, inserted into claims 10 and 11 for the purpose of specifically limiting these claims to a muzzle-loading device. The entire mode of operation of the device is changed by reason of such limitation.

Defendant does not use this construction and therefore does not infringe.

In the instant case it appears that the Trial Court has construed the claims in an unwarranted and improper manner. It is improper to rewrite a claim. The decree of the Trial Court is in error because

“It attempts, not merely to correct a clerical or typographical error, but *to rewrite the claim* and thus enlarge the patent beyond the scope of that which the inventor claimed and the Patent Office allowed. *This the courts have no right to do.*”

*Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. 2d 628 (C. A. 9), citing:

*McClain v. Ortmyer*, 141 U. S. 419, 424;

*Keystone Bridge Co. v. Phoenix Iron Co.*,  
95 U. S. 274, 278;

*Merrill v. Yeomans*, 94 U. S. 568, 573.

“There can be no infringement of a void patent and a patent which shows neither invention nor discovery is void.”

*Dunbar v. Myers*, 94 U. S. 187;

*Thompson v. Baisselier*, 114 U. S. 1;

*Saranac Machinery Co. v. Wire Bounds Co.*, 282 U. S. 704.

Finding 15 of the Trial Court is **contrary to the facts** as shown by the testimony and exhibits of record. There is absolutely no basis whatsoever for the statement: "The infringement by defendants has been and is conscious, deliberate and willful." This last expression is uncalled for, contrary to the record, and appears to be an abuse of discretion. Defendant and defendant's counsel have presented the facts and the authorities in support of their convictions, but this does not excuse such excessive and inordinate language, particularly where the facts definitely sustain defendant's position.

The above circumstances compel defendant to ask that this Court either award costs and attorneys' fees to defendant or reverse the Trial Court and remand the case for determination as to amount of attorneys' fees to be awarded defendant.

### **OBVIOUSLY ERRONEOUS FINDINGS MUST BE OVERHAULED.**

A trial court is under duty to make findings of such character that the basis of the decision reached can be readily understood on appeal. This was called to the attention of the Trial Court [R. 43] and defendant had suggested findings which would be in accordance with the evidence.

Defendant had objected to proposed findings 10 and 11 [R. 36] which were subsequently embodied in large part by the Court in its findings 9 and 10 [R. 67] and defendant's objections and suggested alternatives were set out in full [R. 49-51]. The Trial Court ignored the factual basis of defendant's objections.

We are faced with findings which are a statement of conclusions; the findings, such as 9 and 10, do not identify

what was the “new result” or the “new combination” because there was **no** “new result” and there is **no** “new combination.” The findings are generalized and uninforming because they are based upon an inference and not on fact. They do not state what constitutes an invention.

“It is not sufficient that the device be new and useful. It must also be an invention or discovery.”

*Lane Wells Co. v. M. O. Johnston Oil Field Service*,  
181 F. 2d 707 (C. A. 9).

The situation here is identical to that which caused the Supreme Court to comment (in holding a patent invalid):

“Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it.”

*Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

Because of the burden of work, this Court should not be faced with the necessity of examining the detailed facts. However, when faced with generalized, erroneous findings, this Court has not hesitated to examine the facts and reverse the Trial Court.

“However, this court has not hesitated when convinced that a device showed neither novelty nor invention to so hold notwithstanding findings to the contrary by the trial court. See *Motoshaver, Inc. v. Schick Dry Shaver*, 1940, C. A. 9, 112 F. 2d 701; *Madsen Iron Works v. Wood*, 1943, C. A. 9, 133 F. 2d 416; *Wilson v. Byron Jackson Co.*, 1943, C. A. 9, 133 F. 2d 644; *Schnitzer v. California Corrugated Culvert Co.*, 1944, C. A. 9, 140 F. 2d 275. And see, *Altoona Theaters v. Tri-Ergon Corp.*, 1935, 294 U. S.



477; Paramount Publix Corp. v. Tri-Ergon, 1935, 294 U. S. 464; Universal Oil Products Co. v. Globe Oil and Refining Co., 1944, 322 U. S. 471, 473; Stuart Oxygen Co. v. Josephian, 1947, C. A. 9, 162 F. 2d 857.”

*Pointer v. Six Wheel Corp.*, 177 F. 2d 153 (C. A. 9).

Defendant has presented, in this brief, the basic facts and evidentiary matter which **compels a finding of lack of invention and a finding of no infringement**. These facts have been presented as concisely as possible in order to facilitate action by this Court. Defendant hopes that the showing has been made without impugning the sincerity of the Trial Court. Defendant is confident that the facts compel reversal of the Trial Court.

### **DEFENDANT SHOULD BE AWARDED COSTS AND REASONABLE ATTORNEYS' FEES.**

In view of the glaring error of the Trial Court in holding claims 10 and 11 valid and in finding infringement where no infringement exists, Sections 4-9 of the Judgment [R. 73] must be reversed, and the injunction which was issued must be discharged.

It is respectfully submitted that the Trial Court not only erred in finding infringement, but abused its discretion in assessing costs against defendant [Section 7 of Judgment, R. 73] and in indicating a desire to impose increased damages and attorneys' fees upon defendant [Section 8 of Judgment, R. 74]. This “relief” goes **beyond the prayer** of the complaint [R. 8].



On the contrary, it is earnestly contended that defendant is entitled to costs and attorneys' fees both below and on this appeal, for the following reasons:

- (1) The action was not brought in good faith. Plaintiff knew that the Fourth Circuit, in speaking of the patent in suit, stated:

“The validity of the patent is not free from doubt, but the question need not be decided here; \* \* \*”

*Triumph Explosives, Inc. v. Kilgore Mfg. Co.*, 128 F. 2d 444.

Plaintiff first accused defendant of infringing all twenty-three claims, caused defendant to prepare its defense accordingly, and then reduced the claims piecemeal.

Plaintiff admitted, at the end of the trial, that claims such as 1 were anticipated by Exhibit F-3 [Tr. p. 321]; there voluntarily admitted that claims 6 and 12-23 were not infringed; then admitted that claims 7 and 8 were invalid [R. 154]; then admitted claim 6 was invalid [R. 154]; and finally admitted that claims 12-23 were invalid [R. 155].

A plaintiff who readily admits invalidity of the majority of claims of its patent did not bring the action in good faith. The prior art was of record two years before trial.

- (2) Plaintiff, by its admissions made two years before trial, had stripped the patent of any pretense of invention or validity. To assume that plaintiff's counsel did not know the import of plaintiff's sworn admissions would necessitate questioning such counsel's ability.

- (3) Plaintiff attempted to repudiate its admissions and throughout the trial engaged in evasive and dilatory tactics.
- (4) Plaintiff took unnecessary depositions in Ohio and caused defendant to assume needless expense. The depositions showed that records were in existence, but such records were not produced [R. 95, 99, 105]. Some depositions were not introduced into the record.
- (5) Baseless assertions were made during trial and in various pleadings. Plaintiff disregarded rules of court; evasive answers and silly contentions imposed a great burden on defendant.
- (6) These confusing tactics not only delayed and prolonged proceedings but resulted in confusion of the Trial Court and a miscarriage of justice. Such tactics should not be encouraged; instead, the provisions of 35 U. S. C. A., Section 70, should be invoked and defendant's prayer to attorneys' fees and costs [R. 30] should be granted.

In the instant case, although the Trial Court did not assess any specific sum as attorneys' fees against defendant, the Court indicated its temper in Sections 6, 7 and 8 of the Judgment [R. 73-74]. This Court is therefore in position to reverse the Judgment, hold the patent invalid and not infringed, and direct the Trial Court to award attorneys' fees to defendant, in an amount to be determined by the Trial Court. Such procedure would effectuate the Congressional intent of 35 U. S. C. A., Section 70:

"The provision is also made general so as to enable the court to prevent a gross injustice to an alleged infringer."

Here, defendant did not infringe; defendant was not guilty of unfair competition; defendant's counterclaim for declaratory judgment holding all claims invalid was successful in that plaintiff admitted that claims 6 and 12 to 23 were invalid and officially disclaimed these claims after trial [note disclaimer to Plaintiff's Exhibit 1, R. 191]. Defendant is therefore entitled to the protection of 35 U. S. C. A., Section 70, pursuant to Congressional intent, and should be awarded attorneys' fees and costs as between solicitor and client, in accordance with long standing practice (*Guardian Trust Co. v. Kansas City Southern Ry. Co.*, 28 F. 2d 233, 240-246 (C. A. 8)).

## SUMMARY AND CONCLUSION.

In order to save this Court's time, defendant-appellant has presented the matter concisely. The plates should be helpful in graphically summarizing controlling points and in crystallizing the issues.

The record unequivocally establishes:

- (1) That the patent in suit is in a crowded art. The patentees were professional inventors, obtaining numerous patents on very minor modifications of the same device. Their prior, expired patents were held invalid by the Fourth Circuit.
- (2) The only possible novelty lay in the use of a container having an integral bottom instead of a separate bottom grasped by the walls of the container. **This is a mechanic's choice and not invention**, particularly since one-piece shells of various kinds had been shown in the prior art.

- (3) The sworn admissions of plaintiff, as well as the clear teachings of the prior art, make it impossible to find invention in claims 10 and 11 of the patent in suit.
- (4) Claims 10 and 11 are invalid because:
  - (a) They do not define invention.
  - (b) They are for an old combination of parts, each part performing the same function and result as it performed in prior patents.
  - (c) They are for incomplete and inoperative combinations; they do not define invention with the certainty required by R. S. 4888 (35 U. S. C. A. 33).
  - (d) They are not limited to the alleged novelty but instead attempt to cover elements and combinations which are in the public domain.
- (5) Claims 10 and 11 are specifically limited to a muzzle-loading shell. **Defendant has not made a muzzle-loading shell and has not used the construction defined in these claims.** Defendant has not infringed.
- (6) The findings and conclusions of the Trial Court are contrary to the evidence and the law. The findings fail to define wherein invention can be found.
- (7) Obviously erroneous findings cannot be permitted to stand. There is no excuse for a finding of willful and deliberate infringement when in fact there was no infringement.

- (8) The record shows that plaintiff did not bring the action in good faith, and made representations which were contrary to express admissions. Plaintiff's baseless assertions, vacillating action and repudiation of admissions unnecessarily prolonged trial and imposed an unnecessary burden on defendant. The apparent confusion of the Trial Court, resulting in an erroneous judgment, was largely attributable to plaintiff's tactics. Defendant should be awarded costs and attorneys' fees both below and on appeal.
- (9) The judgment of the Trial Court should be reversed by holding claims 10 and 11 invalid and not infringed, and by awarding costs and attorneys' fees to defendant.

Dated at Los Angeles, California, this 20th day of June, 1951.

Respectfully submitted,

C. A. MIKETTA,

W. W. GLENNY,

*Attorneys for Defendants-Appellants.*

